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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,068	04/20/2000	Christopher Phillips	04814.P017	5825

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,068

Applicant(s)

PHILLIPS ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-25 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment filed 12/6/2004.

Response to Amendment

2. claims 1, 8, 9 have been amended.

Response to Arguments

3. Applicant's arguments regarding 35 USC 101 rejection of method claims as being not within technological art have been fully considered but they are not persuasive. See explanation under 35 USC 101 Rejection.

4. Rejection of claims under 35 USC 112(second) have withdrawn.

5. In response to the Declaration under 37 CFR \$1.131, rejection of claims over prior art reference of Breck et al. under 35 USC \$102(e) have been withdrawn.

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6. Claims 1-4, 6-8, 10-13, and 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims not recited within technological art. (claims 2, 4-8, 10-13, 17 and 20-25)

Note that the claim 1 fails to show any interaction with the first or the second web site (since the billing data is only intended to be used for such interaction) and therefore the steps of "providing a first billing data" and "providing a second billing data" is broadly interpreted as a non-technological process. For example, the billing service (e.g. a credit card provider) can send the "temporary card number" via a postal service. This claimed invention merely recites an abstract idea without any concrete, useful and tangible result produced as a result of the providing of the first and the second billing data. The claimed invention is therefore analyzed as non-statutory under 35 U.S.C. §101.

Dependent claims 2, 4-8, 10-13, 17 and 20-25 are analyzed similarly as being non-statutory under 35 U.S.C. §101. Claims do not produce "useful, concrete and tangible" result (claims 1-4, 6-8, 10-13, 17 and 20-25)

Claims do not produce a "useful concrete and tangible" result

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Another requirement for a claimed invention to be statutory under 35 U.S.C. §101 is that the claimed invention must be directed to a useful concrete and tangible result.

State Street Bank v. Signature Financial Group, 47 USPQ2d 1596 (Fed. Cir. 1998)

If a computer related invention produces a concrete and useful result, it is patentable subject matter, provided that other conditions for patentability are satisfied.

However, in the instant case claim 1 fails to produce such a result, which meet this requirement. The claimed invention merely recites an entity such as a billing service provider (e.g. a credit card provider) providing a first and a second billing data (e.g. temporary card numbers) intended for conducting transactions with a predefined web sites (such as merchant websites).

Since merely providing billing data to the user for the intended use of conducting transaction with a web site does not require the web site or technology, the claimed invention does not produce "useful, concrete and tangible" result as per requirement of under 35 U.S.C. §101.

Claim Rejections - 35 USC § 112

8. Claims 4, 6, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4,6 and 9 further limits the first billing data which does not further limit the act of providing the billing data. Such limitation which does not effect the process step is interpreted as non functional descriptive material, because the process step of the method is carried out regardless of the nature of the billing data.

Claim 9 recites limitation "the user conducting transactions with the web site" which lacks antecedent basis because there is no such step recited in claim 1.

Claim Rejections - 35 USC § 102

9. Claims 1-21, 25, 43-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Flitcroft (US Pat. 6,636,833).

Claim 1: Flitcroft discloses a method comprising:

a billing service providing a first billing data for exclusive use by a user to conduct transactions with a first web site; and

the billing service providing a second billing data, separate and distinct from the first billing data, for exclusive use by a user to conduct transactions with a second web site.

(see col. 10 L 25-55 capability of transmitting the limited-use credit card numbers to customers, see col. 16 L 16 L

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46-59 .. alternatively, a credit card number can be used, for example, to implement an installment plan where the credit card number is, for example, only valid for twelve payments for a pre-arranged transaction limit for twelve months to a single merchant. This plan provides security against fraud because it is locked to a single merchant, and it is only good for one year. Or similarly, a credit card number can be used to implement a debit plan where the credit card number is limited to a specific merchant. When the limited-use number is limited to a specific merchant, the merchant can be prearranged by the user or can be determined by first use. See col. 19 L 22-34)

Claim 2. the billing service providing the first billing data to the user in advance of the user registering with said first web site.

(col. 10 L 25+ limited-use credit card numbers .. delivered to the to the customer via the mail)

Claim 3. Breck recites: billing service providing the first billing data to the user in real time while the user registering with said first web site (col. 10 L 25+ .. electronically downloaded).

Claim 4. wherein the first billing data comprises a first credit card identifier, and the second billing data comprises a second credit card identifier, separate and distinct from said first credit card identifier (see claim 1 analysis, Flitcroft explicitly teaches that the billing data is credit card numbers and see "randomness in credit card numbers" as discussed at col. 12, L10 which indicate distinctness of the credit card numbers)).

Claim 6. wherein the first billing data corresponds to a selected one of an advance debit charge, a real-time credit charge, or a post-transaction invoicing arrangement, and the second billing data corresponds to a selected one of an advance debit charge, a real-time credit charge, or a post-transaction invoicing arrangement, said second billing data separate and distinct from said first billing data.

(col. 16, L 43 refer to "wide range of financial transactions" "pre-arranged transaction limit" , "debit plan", note also that in alternative fashion, the credit card number corresponds to a real-time credit charge as facilitating electronic purchase transactions).

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Claims 7: said first web site requiring first payment format;

paying for a transaction with said first web site according to said first payment format;

[see col. 15 L 25-30 "correct format for a credit card number with a valid check sum"];

billing the user according to a private billing data different from said first billing data.

[[see col. 15 L 25-30, see master credit card number]

Claims 8 and 9 are similarly analyzed as claim 7.

Claim 10. The method of claim 1, further comprising: the billing service obtaining said first billing data from a financial institution (col. 12 L 38 -41 "issuing bank").

Claim 11. wherein the billing service providing said first and second billing data comprises:

the billing service selecting said first and second billing data from a plurality of distinct billing data provided to said billing service (col. 10 L 66 - col. 11 L 5).

Claim 12. the billing service contacting a financial institution to obtain the plurality of distinct billing data from the financial institution , and

receiving the plurality of distinct billing data from the financial institution.

(see col. 14 L 59- col. 15 L 10 and col. 12 L 38 - col. 12 L 63)

Claim 13. The method of claim 1 , further comprising: the billing service obtaining in real time at least one of said first and second second billing data from a bank.

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(col. 12 L 38- 63 " route the credit card number ..to appropriate server)

Claim 14. The method of claim 1 , further comprising:
the billing service pre-obtaining said first billing data
from a bank; and

during a transaction with said first web site, the billing
service providing said first billing data in real time from the
billing service.

(see col. 12 L 38-53, col. 10 L 25-55, "electronically
downloaded to the user's personal computer").

Claim 15. The method of claim 14, further comprising:
the billing service receiving a plurality of billing data
from the bank; and
selecting said first billing data from said plurality of
billing data.

(see col. 11-12 section 2.2 Allocation of the credit card
numbers)

Claim 16. The method of claim 14, wherein said obtaining
by the billing service of said first billing data is performed
during the
transaction with said first web site.

(see Figure 6, steps 602-612)

Claim 17. The method of claim 1, further comprising:
the billing receiving a notification of usage of said first
billing data with said first web site;
wherein said notifying allows the billing service to
confirm charges to said first billing data by said first web
sites.

(see section 2.6 processing of card transaction).

Claim 18. The method of claim 17, further comprising:

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wherein said notifying of the billing service occurs substantially with providing said first billing data to said first/second web site.

[see section 2.6 processing of card transaction].

Claim 19. The method of claim 17, further comprising: wherein said notifying of the billing service occurs after providing of said first billing data to said first web site.

[see section 2.6 processing of card transaction].

Claim 20 and 21 Breck explicitly discloses
..receiving charges to said first and second billing data;
and
..organizing said received charges based at least in part on whether the charges are applied to the first or the second billing data.

(see col. 24 L 42-62)

wherein said organizing is based on whether a charge to first second billing data is received from the first web site.

(see col. 24 L 42-62).

Claim 25. the first web site is a selected one of a content provider, a service provider and an access provider (refer to Fig. 1 and col. 9 L 40+ and claim 13).

Claim 43. analyzed per method claim 1.

Claim 44. analyzed per method claim 2.

Claim 45. analyzed per method claim 3.

Claim 46. wherein use of said first billing data is restricted to transactions between the user and said first web site. (see claim 1 analysis)

Claim 47. analyzed per method claim 6.

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Claim 48. analyzed per method claim 8.

Claim 49. wherein the apparatus is embedded within a host selected from a set of hosts consisting of: a computing device, an electronic card, a telephone, a personal digital assistant (PDA), a portable audio device, a portable audiovisual device, a cellular telephone, a key-chain dongle, and a transportation device.

(col. 10 L 25-55)

Claim 50. (refer to claim 1 analysis)

Claim 51. the programming instructions when executed by the processor, configure the network interface to connect to a billing service

(see Fig. 1).

Claim 52. wherein the programming instructions, when executed by the processor, enable the apparatus to provide in real time said first/second billing data to an electronic device used by the user

(see analysis of claim 14).

10. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flitcroft as applied to claim 21 above.

Claims 22-23: Flitcroft fails to disclose limitation of the billing service disputing..charges to said billing data

(interpreted herein as temporary credit transaction/card number)

not received from the web site to which said billing data was provided.

Official is notice is taken that providing for disputing credit card charges from a merchant web site is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention

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to implement these limitations because it would allow the user to have removed any unauthorized charges from his/her account and receive appropriate credit for the unauthorized charges.

Claim 24. Flitcroft fails to disclose limitation of a single press of the control to issue instruction of the user.

Official is notice is taken that providing for a single press of the control to issue instruction to carry out commercial transaction is and well known business practice.

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement a single press of the control to issue instruction which would eliminate need for the user to enter a plurality of instruction parameters related to the disputed charges.

Conclusion

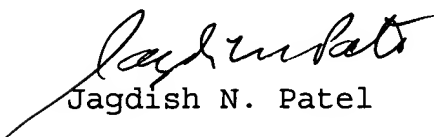
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

2/22/05